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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,696	08/31/1999	GEORGE GOICOECHEA	BSI-212	2901

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EXAMINER

BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/11/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

# Office Action Summary

Application No.

09/387,696

Applicant(s)

GOICOECHEA ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 54-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 16 December 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 16, 2003 has been entered.

### ***Drawings***

2. The proposed drawing correction (Figure 2A) and/or the proposed substitute sheets of drawings, filed on December 16, 2002 have been approved by the Examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 54-61 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

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possession of the claimed invention. The “generally straight intermediate portions” (see claims 54-60) or “connecting member” (see claim 61) were not disclosed/described in the specification.

The Response filed December 16, 2002 discloses “(see, e.g., FIGS. 1A-4A and 5-7 (the parts or portions of the wire that connect the apices with one another to form a sinuous path)).”

The Examiner could not find any specific reference (column, lines) to “generally straight intermediate portions” or “connecting member” throughout the disclosure.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 54, 57, and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by MacGregor (US 4,994,071). MacGregor discloses a tubular prosthesis having a tubular surface being axially subdivided into two or more hoop-like tubular portions formed from corrugated portions of two or more wires or filaments and connected by straightened extension portions (see Abstract; column 2, lines 23-36; column 4, lines 1-10; Figures 1 and 1A). It should be noted that Figure 1A clearly shows “at least two of said hoop-like tubular portions are axially arranged **generally adjacent to one another**”.

7. Claims 60 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Maeda et al. (WO 93/13825). Maeda et al. disclose a stent meeting the general structure and limitations of claims 60 and 61 (see Abstract; page 5, lines 23-33; page 6, lines 13-16 and lines 25-27; page 9,

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lines 11-16; Figures 1, 3, and 6). The claim language of claims 60 and 61 clearly reads on Figures 1, 3, and 6.

8. Claims 54, 55, 56, 57, and 59-61 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wolff (US 5,104,404 A; cited in Applicants' IDS). As seen in Figures 1, 2, 4, and 5, Wolff discloses a tubular prosthesis comprising a plurality of hoop-like tubular portions (i.e., stent segments 12) and one or more generally straightened extension portions (i.e., interconnecting hinges 14) connecting consecutive hoop-like tubular portions. It should be noted that the interconnecting hinges 14 are oriented skew (or in a helical pattern) relative to the tubular axis (more clearly seen in Figures 1, 4, and 5).

#### ***Response to Arguments***

9. Regarding 102(b) rejection over MacGregor, Applicant's arguments filed December 16, 2002 have been fully considered but they are not persuasive.

a. Regarding claims 54 and 57, Applicants argue that "Figure 1A of MacGregor shows loops 12 that are separated by at least a loop's axial width. In other words, the gap interposed to separate successive loops 12 is larger than the axial width of the loops themselves. Such a configuration cannot be considered to constitute "hoop-like tubular portions...axially arranged generally adjacent to one another" as recited in Applicants' claim 54". Examiner respectfully disagrees. Figure 1A clearly shows what the claim language of claims 54 and 57 requires: "at least two of said hoop-like tubular portions are axially arranged generally adjacent to one another".

10. Regarding 102(b) rejection over Maeda et al., Applicant's arguments filed December 16, 2002 have been fully considered but they are not persuasive. Maeda et al. teach that each of the

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hoops comprises a plurality of sinuous or zig-zag segments (see page 5, lines 16-19; page 6, lines 13-16; see Figures 3 and 6) having apices in a plane substantially perpendicular to the longitudinal axis of the stent (see Figures 3 and 6). Maeda et al. also teach a connecting segment (filament 32) connecting adjacent hoops and extending along a helical path (see page 5, lines 23-34; see Figures 3 and 6).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:00 a.m.-4:30 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



JGB

February 8, 2003



David H. Willse  
Primary Examiner